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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,276	12/15/2000	David R. Holmes JR.	07039-197001/Side Branch	8127
26191	7590	02/04/2004	EXAMINER	
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA 60 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402			BUI, VY Q	
			ART UNIT	PAPER NUMBER
			3731	14
DATE MAILED: 02/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/736,276

Applicant(s)

HOLMES ET AL.

Examiner

Vy Q. Bui

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) 10-14, 24-27, 30 and 31 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9, 15-23, 28-29, 32 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 13.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-2, 28-29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by GINSBURG et al (4,769,005).

As to claims 1-2, GINSBURG (Fig. 1-5; abstract) discloses a catheter shaft 12 having four lumens 20/22/24/26 communicating to four openings 32/34/28/36 respectively (column 3, lines 14-41) for guiding guidewires into an artery and a branch vessel (Fig. 5). GINSBURG (column 4, lines 1-3) also discloses using radiopaque

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markers 54 adjacent to lateral exit openings 32/34/36 for locating the openings and the catheter.

As to claims 28-29 and 32, GINSBURG (Fig. 5; abstract; claims 11-12 and 14) discloses a catheter shaft 12 having four lumens 20/22/24/26 communicating to four openings 32/34/28/36 respectively (column 3, lines 14-41) and radiopaque markers for guiding guidewires into an artery and a branch vessel and inherently discloses a method of using the catheter as recited in the claims.

2. Claims 15, 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by WILSON (6,221,090).

As to claims 15, WILSON (Fig. 16A-16D) discloses a catheter shaft 50 having guidewire lumen 53A and guidewire 41C for main vessel, lumen 55A and guidewire 56A for branch vessel.

As to claims 28-29, WILSON (Fig. 16A-16D) discloses a catheter shaft 50 having guidewire lumen 53A and guidewire 41C for main vessel, lumen 55A and guidewire 56A for branch vessel and therefore inherently discloses a method of using the catheter as recited in the claims.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-9, 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILSON (6,221,090) in view of MUKHERJEE (6,022,342).

As to claim 3 and 16-17, WILSON discloses substantially all structural limitations as recited in the claim, except for radiopaque markers 54 including at least one stud attached to the catheter shaft. MUKHERJEE (Fig. 2; column 5, lines 23-27) shows lateral opening 42 placed in the middle of two radiopaque markers 43 and 45 for easy identifying the lateral opening 42 as compared to Fig. 8 of the present invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place radiopaque markers in the WILSON catheter as recited in the claims, as this configuration would facilitate identifying the openings of lumen 53A and 55A during a surgical procedure.

As to claims 4-9 and 18-23, WILSON discloses substantially all structural limitations as recited in the claims, except for different designs of the radiopaque markers as claimed. It would have been an obvious matter of design choice to modify WILSON radiopaque markers as claimed. It appears that the WILSON catheter and the catheter as described in the present invention would perform equally well with any

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design of radiopaque markers as long as the markers are placed adjacent to an opening to help a surgeon to locate the opening.

### ***Response to Arguments***

Applicant's arguments filed 3/24/2003 have been fully considered but they are not persuasive.

The invention as claimed in independent claims 1, 28 do not require two guidewires simultaneously accessible from the first end of the shaft or any specific order of using the guidewires.

Applicant's amendment with respect to claim 15 has been considered but is moot in view of the new ground(s) of rejection over new reference WILSON-'090.

Further, a modification of locations/manners of placing radiopaque markers in a GINSBURG or WILSON device is considered as a design choice, which would be quite within the level of one of ordinary skill in the art to make a proper choice. Therefore, it would be reasonable to maintain the 103(a) rejection as presented above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  

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VQB  
1/30/2004.